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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,229	01/29/2001	Jun Abe	P 275670 SH-0023-US	8815
7590	05/04/2004		EXAMINER	
PILLSBURY WINTHROP LLP 1600 TYSONS BOULEVARD MCLEAN, VA 22102				HOFFMANN, JOHN M
		ART UNIT		PAPER NUMBER
		1731		

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/770,229	ABE ET AL.
	Examiner	Art Unit
	John Hoffmann	1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 21 April 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) 8 is/are allowed.

6) Claim(s) 1-7, 9 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4,9 are rejected under 35 U.S.C. 102(b) as being anticipated by Berkey 4629485.

The method is disclosed at col. 8, lines 21-68 and col. 5, line 39. See figure 8 which shows the gradual decrease in the refractive index. As to the new free from germanium limitation: Col 8, lines 25-26 refers to using a dopant “such as GeO₂”. It is clear that this means one can use other dopants, besides GeO₂. Using a different dopant would result in soot free from germanium. Moreover, some of the soot is free from GeO₂ –as per figure 8 of Berkey. The claim is comprising in nature an is open to accumulating extra soot that is not GeO₂ free. The density of fluorine limitation is clearly disclosed in figure 8 of Berkey.

Claim 2: col. 8, line 50-54 discloses the control of the atmosphere. Although there is no mention of the sintering speed being controlled per se, by controlling the temperature, one inherently is controlling the speed. Alternatively, lines 49-50 discloses controlling the sintering to be uniform - thus the speed must also be uniform.

Claim 4 is inherently met. As indicated at page 9, lines 9-22, Applicant discloses that it is impossible to use the invention if the density is outside the claimed range. Since Berkey uses the invention, it must not be outside the range.

Claim 9: See col. 8, line 30-32 of Berkey. The second to last pass would be "substantially" the same as pure quartz.

Claims 1 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Berkey 5917109.

Figure 4 shows the core forming step. Col. 9, lines 50-55 discloses the forming of the clad around the core.

Getting back to the core forming step: col. 8, lines 15-20 discloses the claimed accumulating. The sintering in an atmosphere with the compound gas is disclosed at col. 8, lines 22-26. For the intention of creating a GI type refractive index profile core: see figure 7 and col. 9, lines 18-20.

Claim 9 : see col 8, line 45-57, especially 57.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkey 4629485.

Page 9, lines 3-5 of Applicant's specification discloses that the scope of "recognizing" the density includes using a predetermined process. It would have been obvious to the artisan using Berkey to repeat the method using the same parameters each time, so that one can make a uniform/identical process each time. One using the same parameters each time would recognize that the density would have been the same each time, alternatively one would recognize that the density would be "adequate." Alternatively, it would have been obvious that the artisan would have recognized that the density is less than "full" because the preform would not be transparent.

As to the steps of determining the gas content and sintering speed: it would have been obvious to perform routine experimentation to determine the optimal processing parameters. The setting of the parameters will inherently set the gas content and sintering speed.

IT is noted that the present specification does not set forth a single example as to how applicant recognizes the density or determines the gas content and sintering speed. Nor is there any indication as to what the claim language excludes.

Claim 7: Berkey discloses 4 mm/minute (col 6, line 41) - it would have been obvious to change the parameters so that one can increase the feed rate, so that one can sinter the preform faster.

Claims 1-5, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkey 4629485 in view of Kanamori 5055121.

See how Berkey is applied above. Berkey does not disclose monitoring the density. Col. 2, lines 18-19 of Kanamori disclose that the upper limit for easy addition of fluorine is no higher than 0.5 g/cc. It would have been obvious to one of ordinary skill to perform routine experimentation to determine the optimal density so that one can easily add fluorine, as disclosed by Kanamori. Alternatively, it is deemed that the 0.5 g/cc teaching of Kanamori informs the artisan of the usefulness of densities within the present claimed range of 0.15-0.4 of present claim 5.

Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berkey 5917109.

Claim 2: See above how Berkey meets claim 1's limitation. Col. 8, lines 22-26 discloses the controls of the gas content: alternatively, it would have been obvious to control it to be what Berkey discloses, because that is the easiest way to get the Berkey atmosphere conditions.

Berkey does not disclose the sintering speed (as defined by applicant) - see col. 8, lines 22-23 which broadly identifies the sintering, but gives no indication as to how to do it. Col 9, lines 23-45 discloses sintering by moving a soot body downward at 5 mm/min. It would have been obvious to use the col. 9 sintering process for the col. 8 sintering, because some sintering method is needed and for the advantage of being able to use the same furnace, and that the technician would only need to be proficient

at one type of sintering method, i.e. zone sintering. It is noted that Berkey uses the same consolidation furnace - this suggests that the same sort of sintering is used. It is further noted that this obvious modification is not to suggest that the gases and/or temperatures should be identical in both sintering process, rather that zone sintering be used in each instance.

Claim 6: see col. 8, line 25: the gas concentration is approximately 5 vol. %

Claim 7: see col. 9, line 29.

Response to Arguments

Applicant's arguments filed 4/21/04 have been fully considered but they are not persuasive.

AS to the IDS: whereas the office did receive copies of English-language abstracts with the March 12, 2003 submission, such did not include the patents themselves.

It is argued that Berkey creates a fiber that is doped with germanium. As indicated above, the claim does not preclude all germanium from all portions of the preform. The claims only require that some soot is accumulated that is free from germanium. The claim is comprising in nature and is open to having other soot which isn't germanium free. Furthermore, Berkey discloses using dopants other than germanium (see the above rejection for more details).

IT is also argued that Examiner failed to indicate the source of the desirability of the motivation is in the references. Even if this argument is accurate, it is not relevant. Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). For example, making things portable, integral, separable, adjustable, or automatic are a few obvious modifications that come from knowledge generally available to one of ordinary skill as set forth in well-established case law. The rejection clearly states the complete rationale for the holding that the invention was an obvious one. See rejection. Moreover, the rejection clearly points out that "Col. 2, lines 18-19 of Kanamori disclose that the upper limit for easy addition of fluorine is no higher than 0.5 g/cc. " This is a very strong teaching not to exceed 0.5 g/cc.

It is still further argued that Kanamori cannot be combined with Berkey, because it would render Berkey unsatisfactory for its intended purpose. However, there is no indication as to why combining the two references would render Berkey unsatisfactory. Although the argument says that if no germanium was present, the Berkey purpose would be contradicted. Combining the two references would NOT result in changing the germanium in Berkey. The combination only alters the fluorine concentration NOT the germanium.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John Hoffmann
Primary Examiner
Art Unit 1731

4-30-04

jmh